

REMARKS

Claims 1 and 33-90 are all the claims pending in the application, of which claims 65-90 are withdrawn. By this Amendment, Applicant amends claims 1 and 58.

Claim Rejections - 35 U.S.C. § 102

Claims 1, 33-37, 39, 40, 51, 58-62, and 69 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Yoshio et al. (JP 04-310631, hereinafter “Yoshio”). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 1, 58, and their dependent claims would not have been anticipated by Yoshio for at least the reasons (Argument, § I) set forth at pages 5 to 14 in the Appeal Brief previously filed on October 15, 2008.

To the extent that the Examiner’s position (“Response to Arguments”) at page 42 of the Office Action is based on the assertion that:

In response to applicant’s argument that Yoshio does not teach a receiver, it is noted that Yoshio discloses receiving equipment at page 23, line 12.

Applicant respectfully submits that the Examiner has misconstrued Applicant’s argument previously presented in the Appeal Brief filed on October 15, 2008. Contrary to the Examiner’s assertion, Applicant does not assert that “Yoshio does not teach a receiver.” Instead, Applicant respectfully submits that Yoshio does not disclose the receiver including the combination of features recited in claim 1, as discussed (Argument, § I.A) at pages 6 to 9 of the Appeal Brief filed on October 15, 2008.

To the extent that the Examiner’s position (“Response to Arguments”) at page 42 of the Office Action is based on the assertion that:

In response to applicant's argument that Yoshio does not teach a user interface, it is noted that Yoshio discloses presentation items via a menu and submenus, see page 23, lines 25-27.

Applicant respectfully submits that the Examiner has misconstrued Applicant's argument previously presented in the Appeal Brief filed on October 15, 2008. Contrary to the Examiner's assertion, Applicant does not assert that "Yoshio does not teach a user interface." Instead, Applicant respectfully submits that Yoshio does not disclose the receiver including the "user interface" recited in claim 1, as discussed (Argument, § I.A) at page 7, first paragraph of the Appeal Brief filed on October 15, 2008.

To the extent that the Examiner's position ("Response to Arguments") at page 42 of the Office Action is based on the assertion that:

In response to applicant's argument that Yoshio does not teach a memory, it is noted that recording functionality is disclosed at page 23, line 13.

Applicant respectfully submits that the Examiner has misconstrued Applicant's argument previously presented in the Appeal Brief filed on October 15, 2008. Contrary to the Examiner's assertion, Applicant does not assert that "Yoshio does not teach a memory." Instead, Applicant respectfully submits that Yoshio does not disclose the receiver including the memory and other features recited in claim 1, as discussed (Argument, § I.A) at pages 6 to 9 of the Appeal Brief filed on October 15, 2008.

To the extent that the Examiner's position ("Response to Arguments") at page 42 of the Office Action is based on the assertion that:

In response to applicant's argument that Yoshio does not teach a speech producing sub-system coupled to the controller and the memory of the claimed receiver, it is noted that Yoshio teaches a speech producing sub-system coupled to the controller and the memory for converting the selected data from digital form to an analog signal, see page 23, lines 21-23.

Applicant respectfully disagrees. As at least discussed at page 7, second paragraph of the Appeal Brief filed on October 15, 2008, the speech producing sub-system in Yoshio is implemented at the broadcasting station before the signals are broadcasted by the broadcasting station. There is no teaching or suggestion that any speech producing sub-system is implemented at the receiver in Yoshio.

To the extent that the Examiner's position ("Response to Arguments") at pages 42 and 43 of the Office Action is based on the assertion that:

In response to applicant's argument that Yoshio is not enabling, the examiner stipulates that prior art (including publications) does not *have* to be enabled to teach the inventive features. Apparently Applicant confuses the Scope of Enablement under 35 USC § 112 (1) (enabling requirements to the Specification of the patent application) with the teaching of the prior art.

Applicant respectfully requests the Examiner to cite to authority for the position that "prior art (including publications) does not *have* to be enabled to teach the inventive features."

Moreover, Applicant respectfully directs the Examiner to MPEP § 2121.01, which recites, *in part* (emphasis added):

"In determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema*, 399 F.2d 269, 158 USPQ 596 (CCPA 1968). **The disclosure in an assertedly anticipating reference must provide an enabling disclosure** of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. ^{*>Mayo Found. For Med. Educ. & Research}*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003) (At issue was whether a prior art reference enabled one of ordinary skill in the art to produce Elan's claimed transgenic mouse without undue experimentation. Without a disclosure enabling one skilled in the art to produce a transgenic mouse without undue experimentation, the reference would not be applicable as prior art.). A reference contains an "enabling disclosure" if the public was in possession of the claimed invention before the date of invention. "Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the

invention with his [or her] own knowledge to make the claimed invention." *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985).

Applicant respectfully submits that the Examiner's position, "prior art (including publications) does not *have* to be enabled to teach the inventive features," is inconsistent with U.S. patent law, as shown above.

To the extent that the Examiner's position ("Response to Arguments") at page 43 of the Office Action is based on the assertion that:

In response to applicant's argument that the invention had commercial success, the examiner points out that evidence of secondary consideration is not applicable to Claim Rejections under 35 USC 102:

2131.04 Secondary Considerations

Evidence of secondary considerations, such as unexpected results or commercial success, is irrelevant to 35 U.S.C. 102 rejections and thus cannot overcome a rejection so based. *In re Wiggins*, 488 F.2d 538, 543, 179 USPQ 421, 425 (CCPA 1973).

Applicant respectfully submits that the Examiner has misconstrued Applicant's argument previously presented in the Appeal Brief filed on October 15, 2008. Contrary to the Examiner's assertion, Applicant does not assert that secondary considerations are applicable to rejections under 35 U.S.C. § 102. Instead, Applicant respectfully submits that "Yoshio Does Not Render Obvious Claims 1 and 58" under 35 U.S.C. § 103, as discussed (Argument, § I.B) at pages 14 to 20 of the Appeal Brief filed on October 15, 2008.

Claims 1, 33-37, 45, 49, and 58-62 are rejected under 35 U.S.C. § 102(a) as allegedly being anticipated by Browne et al. (WO 92/22983, hereinafter "Browne"). Applicant respectfully traverses the rejection.

Claims 1 and 58

Claim 1 recites, *inter alia*:

a tuner for receiving a broadcast signal including data, the data comprising at least one from among compressed audio data and alphanumeric data.

Applicant respectfully submits that Browne neither teaches nor suggests this claimed feature. This is because Browne does not disclose or suggest receiving broadcasting signals having “compressed audio data” or “alphanumeric data.” Instead, Browne is limited to receiving broadcasting signals from air and ground broadcast sources, cable feeds, or digital distribution sources (*see* Browne, p. 6, ll. 1-4). While Browne discloses that the broadcasting signals may be compressed broadcasting signals (*see e.g.*, Browne, p. 6, ll. 5-9), there is no teaching or suggestion that the broadcasting signals in Brown, which are compressed or uncompressed, contain either “compressed audio data” or “alphanumeric data.”

Accordingly, Applicant respectfully submits that Browne fails to teach or suggest this claimed feature. Therefore, Applicant respectfully submits that claim 1 and its dependent claims would not have been anticipated by Browne for at least these reasons.

To the extent that independent claim 58 recite features similar to those discussed above, Applicant respectfully submits that claim 58 and its dependent claims also would not have been anticipated by Browne for at least reasons analogous to those discussed above regarding claim 1.

Claim Rejections - 35 U.S.C. § 103

Claims 38, 41-44, 52, 54-56, 67, and 76 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoshio in view of De Bey (WO 99/03112). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 38, 41-44, 52, 54-56, 67, and 76 should be deemed patentable at least by virtue of their respective dependencies.

Claims 45-50, 57, and 68 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoshio in view of Official Notice. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 45-50, 57, and 68 should be deemed patentable at least by virtue of their respective dependencies.

Claim 53 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoshio in view of De Bey, and further in view of Official Notice. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 53 should be deemed patentable at least by virtue of its dependency.

Claims 1, 33-44, 52, 54-56, 58-62, 67, 69, and 76 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over De Bey in view of Yoshio. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 38, 41-44, 52, 54-56, 67, and 76 would not have been rendered unpatentable by the combination of Yoshio and De Bey for at the reasons (Argument, § II) set forth at pages 21 to 22 in the Appeal Brief filed on October 15, 2008.

Claims 45-50, 53, 57, and 68 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over De Bey in view of Yoshio, and further in view of Official Notice. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 45-50, 53, 57, and 68 should be deemed patentable at least by virtue of their respective dependencies.

Claims 1, 33-37, 49, 52, 54-56, 58-61, and 69 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lang (U.S. Patent 5,057,932) in view of Yoshio.

Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 38, 41-44, 52, 54-56, 67, and 76 would not have been rendered unpatentable by the combination of Yoshio and De Bey for at the reasons (Argument, § III) set forth at pages 22 to 25 in the Appeal Brief filed on October 15, 2008.

Claims 38, 41, 42, 67, and 76 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lang in view of Yoshio, and further in view of Rovira (WO 92/10040).

Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 38, 41, 42, 67, and 76 should be deemed patentable at least by virtue of their respective dependencies.

Claims 39, 40, 45-48, 50, 51, 53, 57, and 68 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lang in view of Yoshio, and further in view of Official Notice. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 39, 40, 45-48, 50, 51, 53, 57, and 68 should be deemed patentable at least by virtue of their respective dependencies.

Claims 43 and 44 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lang in view of Yoshio and Rovira, and further in view of De Bey.

Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 43 and 44 should be deemed patentable at least by virtue of their respective dependencies.

Claim 63 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoshio in view of Ryan (U.S. Patent 5,590,195). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 63 should be deemed patentable at least by virtue of its dependency. Applicant also respectfully submits that claim 63 is additionally patentable for at the reasons (Argument, § V) set forth at pages 26 to 28 in the Appeal Brief filed on October 15, 2008.

Claim 63 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over De Bey in view of Yoshio, and further in view of Ryan. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 63 should be deemed patentable at least by virtue of its dependency. Applicant also respectfully submits that claim 63 is additionally patentable for at the reasons (Argument, § V) set forth at pages 26 to 28 in the Appeal Brief filed on October 15, 2008.

Claim 64 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yoshio in view of Myers et al. (U.S. Patent 5,272,752, hereinafter “Myers”). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 64 should be deemed patentable at least by virtue of its dependency. Applicant also respectfully submits that claim 64 is additionally patentable for at the reasons (Argument, § V) set forth at pages 26 to 28 in the Appeal Brief filed on October 15, 2008.

Claim 64 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over De Bey in view of Yoshio, and further in view of Myers. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 64 should be deemed patentable at least by virtue of its dependency. Applicant also respectfully submits that claim 64 is additionally

patentable for at the reasons (Argument, § V) set forth at pages 26 to 28 in the Appeal Brief filed on October 15, 2008.

Claims 38 and 41-44 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of De Bey. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 38 and 41-44 should be deemed patentable at least by virtue of their respective dependencies.

Claims 39, 52-54, and 56 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of De Bey, and further in view of Official Notice.

Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 39, 52-24, and 56 should be deemed patentable at least by virtue of their respective dependencies.

Claim 40 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of Yoshio. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 40 should be deemed patentable at least by virtue of its dependency.

Claims 40 and 46 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown in view of Guenther et al. (U.S. Patent 5,086,510, hereinafter “Guenther”). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claims 40 and 46 should be deemed patentable at least by virtue of their respective dependencies.

Claim 47 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of Benbassat et al. (U.S. Patent 4,700,322, hereinafter “Benbassat”).

Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 47 should be deemed patentable at least by virtue of its dependency.

Claim 48 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of Whitby et al. (GB 2258102, hereinafter “Whitby”). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 48 should be deemed patentable at least by virtue of its dependency.

Claim 51 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne et al. in view of Date (“An Introduction to Database Systems”). Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 51 should be deemed patentable at least by virtue of its dependency.

Claim 55 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of De Bey, and further in view of Yoshio. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 55 should be deemed patentable at least by virtue of its dependency.

Claim 57 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown in view of Official Notice. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 57 should be deemed patentable at least by virtue of its dependency.

Claim 63 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Browne in view of Ryan. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 63 should be deemed patentable at least by virtue of its dependency.

Claim 64 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Brown in view of Myers. Applicant respectfully traverses the rejection.

Applicant respectfully submits that claim 64 should be deemed patentable at least by virtue of its dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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